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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,744	11/28/2000	John Thaddeus Pienkos		8432

7590

10/10/2003

John T. Pienkos
5017 N. Hollywood Ave.
Whitefish Bay, WI 53217

EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,744

Applicant(s)

PIENKOS, JOHN THADDEUS

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Status of the Claims

1. Claims 1-20 are pending in this application.

Priority

2. This application has a priority date of 3/20/2000 from a provisional application S.N. 60/146878 .

Drawings

3. The 8 pages of informal drawings (15 figures) filed 11/28/2000 are acceptable for examining purposes.

Election/Restriction

4. After reviewing the pending application, the election to one of the following inventions is deemed necessary. The delay of this requirement is regretted by the examiner of the record.
5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, and 13-17 are drawn to a method of facilitating the transfer of Intellectual Property using a computer system, classified in US class 705, subclasses 59, 26.
 - II. Claims 18-20 are drawn to a computer system for facilitating the transfer of intellectual property, classified in class 709, subclasses 200 (i.e., a computer system for data transferring that involves communications among a seller 's computer, a broker's computer, and a buyer 's computer).
6. The inventions (group I and group II) are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as methods and system for its

practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different system or by hand, or (2) the system as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case, (2) confirms that group II is directed to a computer system (having many different computers connected together) can be used to practice a different process (please note that a system as claimed is merely a system for communication between computers that is capable of performing many different processes) such as electronic shopping, trading/bidding in finance transactions, inventory management .etc.) not necessarily using that system for patent/license exchanges.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Mr. John T. Pienkos (Tel. No. 414-332-6289) on 10/10/2003 to request an oral election to the above restriction requirement, but did not result in an election being made; therefore, a formal request for restriction is mailed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone

number is 703-305-4553. The examiner can normally be reached on Mon.-Fri.
from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Mr. Jeffrey A. Smith, can be reached on (703)308-3588

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications]

or 703-746-5572 (RightFax)

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist. Receptionist's telephone
number: (703)308-1113.

Cuonghuy Nguyen
Primary Examiner